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EXAMINER

AVERY, B

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10/08/97 0303

ART UNIT	PAPER NUMBER
3106	7

**DATE MAILED:** 09/08/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/698,853</b>	Applicant(s) <b>Palenchar, Thomas</b>
	Examiner <b>Jonathan E. Butts</b>	Group Art Unit <b>3106</b>

Responsive to communication(s) filed on Jun 2, 1997.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) 7-13, 23, and 24 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1, 3-6, and 14-22 is/are rejected.

Claim(s) 2 is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on Aug 16, 1996 is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2-4

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 14-22 are drawn to an engine air intake system, classified in class 180, subclass 68.3.
- II. Claims 7-13, drawn to a grating for use in an opening, classified in class 55, subclass 385.3.
- III. Claims 23-24, drawn to a method of separating water from air being supplied to an over the highway truck or tractor vehicle engine, classified in class 180, subclass 69.25.

1. Inventions (I and II) and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process as claimed can be used in a materially different product such as in an air cleaning device like a humidifier.

In addition, if the apparatus is elected, the following restriction applies.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed including integrally molded clips and a gasket. The subcombination has separate utility such as being used for an air cleaner to be used inside of a house.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

4. Claims 7-13, 23 and 24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 6.

An action on the merits follows.

1. The Information Disclosure Statements filed on March 26, 1997, October 17, 1996 and August 16, 1996, by the applicant, is acknowledged.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "the wall being spaced from an upper part of the hood, the spacing between the wall and the hood upper part being less than the spacing between the wall and the inlet" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

***Claim Rejections - 35 USC § 112***

3. Claims 14-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 14 recites the limitation "its" in line 24. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 14 recites the limitation "its" in line 28. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 14 recites the limitation "its" in line 29. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 14 recites the limitation "its" in 29. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 19 recites the limitation "its" in line 2. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shern et al. ('323) in view of Petersen et al. ('858).

Shern et al. ('323) teaches an engine air intake system (10) having, a hood (18) with a generally vertical side portion defining an air inlet (54); a flow diverting wall (48) mounted within the hood (18) and positioned in a generally vertical orientation when the vehicle (12) is in use; the wall (48) being spaced from and generally parallel to the inlet (54) to define a part (22) of a relatively large initial portion of an air flow path from the inlet (54) to the engine and to divert upwardly air flowing inwardly from the inlet (54); the wall (48) being spaced from an upper part of the hood (18); and, a water separating choke (34), as broadly recited.

Note, to modify the wall of Shern et al. ('323) to be spaced from an upper part of the hood, where the spacing between the wall and the hood upper part would be less than the spacing between the wall and the inlet would be obvious to one of ordinary skill in the art to provide space for air flow.

Shern et al. ('323) fails to show structure providing a conduit delineating a portion of the path, the conduit communicating the choke with the engine.

Petersen et al. ('858) teaches a conduit (tube extending from element 14) that communicates with the engine; a aperture grating (22) having an endless flange (20) surrounding the grating apertures (22) and disposed around a hood inlet (10); a parametrial section around the flange and extending outwardly from an outer part of the flange in aligned relationship with a surface of the hood side portion; and, an endless skirt (see Figure 4) extending inwardly from the inner circumference of the flange (20) outer part such that in planes of cross section the flange and skirt delineate "v" configurations; the grating apertures (22) collectively form an air intake opening (10) and the skirt defines the perimeter of the air intake opening (10) and wherein baffles (34) extend across the air intake opening, each baffle (34) being connected at its ends to the skirt; the grating (22) also includes integrally molded clips (36, 38) securing the grating (22) to the hood (12); and, the flange

(20) and skirt define a gasket (34) receiving recess and wherein a gasket (34) is in the recess, the gasket (34) providing a water seal (34) between the grating (22) and the vehicle hood (12) and around the air inlet (10).

Based on the teachings of Petersen et al. ('858), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include a grating and structure providing a conduit delineating a portion of the path and communicating with the engine to filter the air entering the engine compartment and to provide dry air to the engine.

11. Claims 14 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shern et al. ('323) in view of Petersen et al. ('858).

Shern et al. ('323) teaches an air intake system (10) having: a pivotally mounted engine hood (18) having a top and two side portions, the hood portions defining an inverted squared "u" configuration in transverse cross section, the hood (18) being pivotal between closed and engine access positions; one of the side portions including a smooth outer surface having a through air intake opening (54); and, structure delineating an air flow and water separation passage extending from the intake passages to an engine, the structure including: a flow diverting wall (48) spaced from and generally paralleling the one side portion when the hood (18) is in a closed position; the wall (48) being spaced from the hood top portion to define a choke (34) in the air flow passage.

Shern et al. ('323) lacks the teaching of a grating and gasket.

Petersen et al. ('858) teaches a self securing grating secured in an opening defined by a flange (20) extending inwardly from an outer surface with flange (20) and skirt (see fig. 4) recess portions defining a parametrial gasket (34) recess; a gasket (34) in the recess and in engagement with the hood flange (20), the gasket (34) providing an endless water seal around the opening (10); the grating (22) having outermost surfaces disposed essentially in an imaginary extension of a contour generated by the side portion outer surface; the grating (22) having baffle portions (34), each having spaced ends connected to one of the recess portions, the baffle portions (34) delineating air intake passages therebetween; and, separable parts (see fig. 1), including a flexible tubular boot of corrugated configuration, defining a section of the air flow passage between the choke and the engine when the hood is in the closed position and being separable to enable movement of the hood from the closed to the engine access position. Note, to modify the grating baffles to be sloped would be obvious to one of ordinary skill in the art to limit the flow of air to a desired direction.

Based on the teachings of Petersen et al. ('858), it would have been obvious to one of ordinary skill in the art at the time of the invention to include a grating to provide a filter for incoming air and to include a gasket to provide resilient biasing between the hood and an air cleaner plate, as taught by Petersen et al.

*Allowable Subject Matter*

12. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.  
*BPO  
9/2/97*

13. Claims 15-~~20~~<sup>10</sup> and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.  
Holm et al. shows a work vehicle of interest.  
Fujikawa et al. shows a internal combustion engine with an air intake system of interest.  
Yamaguchi et al. shows a vehicle body for preventing water suction into an air cleaner of interest.

Any inquiry concerning this communication should be directed to Bridget Avery at telephone number (703) 308-2086.

*Bridget Avery 09/02/97*

Avery

September 2, 1997

*Brian L. Johnson 9/2/97*

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